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WILMERHALE/BOSTON 60 STATE STREET BOSTON, MA 02109			EXAMINER OUELLETTE, JONATHAN P	
			ART UNIT 3629	PAPER NUMBER
			NOTIFICATION DATE 05/28/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/734,811

Applicant(s)

BHAN ET AL.

Examiner

Jonathan Ouellette

Art Unit

3629

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, and 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Claims 7, 9, and 15-18 have been cancelled; therefore, Claims 1-6, 8, and 10-14 are currently pending in application 10/734,811.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-6, 8, and 10-14 are rejected under 35 U.S.C. 101 because the independent claims fails to meet the machine-or-transformation test, and therefore, fails to satisfy § 101 requirements.**
4. The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by Benson and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity (i.e. saving data in a database, displaying data from a database, sending electronic message). See Flook, 437 U.S. at 590.

5. Therefore, because the applicable test to determine whether a claim is drawn to a patent-eligible process under § 101 is the machine-or-transformation test set forth by the Supreme Court and clarified herein, and independent Claims **1-6, 8, and 10-14** plainly fail that test, the claims are rejected.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-6, 8, and 10-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gal et al. (WO 01/52106 A2)**.
8. As per **independent Claim 1**, Gal discloses a method of selectively distributing invitations for a plurality of events (Abstract), the method comprising the steps of: storing in an event information database (Figs. 1-2, Server 26 – database inherent to server) event information about each of a plurality of events (C3 L8-11, the user creates a message and provides profile information – the message would inherently be saved in order to do a query on members, *the message could contain a plurality of message types – to include an event or plurality of events – the type of message would be non-functional descriptive material*), wherein the event information for each of the plurality of events includes one or more corresponding invitee selection criteria (C3 L8-15, profile information); storing in a member information

database (Figs. 2 and 4) member information for each of a plurality of members (C3 L8-15, database of recipients); for each event of the plurality of events, comparing the stored event information obtained from the member information database (Figs.1-4) and the stored member information to identify for each member among the plurality of members all events among the plurality of events that match the stored member information for that member (*system uses profile information attached to message/invitation information for matching recipients to the message/invitation, pg 3, - in the case all events would be the single message being matched*); storing match information about all of the identified matches, wherein for each of at least some of the members among the plurality of members the stored match information identifies multiple events among the plurality of events that were detected for that member (pgs.5-6, Fig.5, multiple invitations stored per user profile/key number); and based on the stored match information, generating and sending an electronic invitation message to the electronic mailbox of each member of the plurality of members for which matches are identified in the stored match information (C2 L11-13, C3 L8-15, C5 L6-12, C6 L7-13)(C3 L8-15, C4 L5-10), wherein each electronic invitation message invites its corresponding recipient to the events for which matches were detected for that corresponding recipient (Invitations, Fig.4, C5 L26-27).

9. Gal fails to expressly disclose receiving an “e-mail” as described by the applicant, wherein each of the plurality of members has a corresponding electronic mailbox for receiving electronic communications for storage and later retrieval by that member.
10. However, Gal does disclose sending invitations which can be done by “e-mail” (pg.4 L8), and it would have been obvious to use a variety of available e-mail formats available at the

time the invention was made to include an e-mail system that included an electronic mailbox for receiving electronic communications for storage and later retrieval by that member, for the purpose of providing customers with a wide variety of formats for receiving sent messages.

11. Furthermore, Gals fails to expressly disclose sending “all of” the matching events/invitations in one e-mail to the user.
12. However, Gal does disclose combining event information by user/key number (pg.5, combined event information disclosed as possible information available), and Gal also discloses electronically sending invitation information to users (pg.4).
13. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included sending “all of” the matching events/invitations in one e-mail to the use in the system disclosed by Gal, for the advantage of providing a method of invitation delivery with the ability to save system resources for both the user and the sender, by combining information sent. (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).
14. As per **independent Claim 6**, Gal discloses a method of selectively distributing invitations for a plurality of events (Abstract), the method comprising: storing in an event information database (Figs. 1-2, Server 26 – database inherent to server) event information about each of a plurality of events (C3 L8-11, the user creates a message and provides profile information – the message would inherently be saved in order to do a query on members; *the message could contain a plurality of message types – to include an event or plurality of events – the*

type of message would be non-functional descriptive material), wherein the event information for each of the plurality of events includes one or more corresponding invitee selection criteria (C3 L8-15, profile information); storing in a member information database (Figs. 2 and 4) member information for each of a plurality of members (C3 L8-15, database of recipients), wherein the member information for each of the plurality of members includes one or more member preferences (C3 L8-15, C5 L6-12, C6 L7-13); for each event of the plurality of events, comparing the stored event information obtained from the member information database (Figs. 1-4) and the stored member information to determine for each member among the plurality of members all events among the plurality of events to which that member should be invited (*system uses profile information attached to message/invitation information for matching recipients to the message/invitation, pg 3, - in the case all events would be the single message being matched*) based on (a) matches between the member information and the at least one invitee selection criterion for each of the plurality of events and (b) matches between the event information and the at least one member preference for the respective members (C2 L11-13, C3 L8-15, C5 L6-12, C6 L7-13); storing invitation information indicating which events among the plurality of events each of the plurality of members should receive an invitation to, wherein for each of at least some of the members among the plurality of members the stored invitation information identifies multiple events among the plurality of events that were detected for the member (pgs.5-6, Fig.5, multiple invitations stored per user profile/key number); and based in the stored invitation information, generating and sending an electronic invitation message to each member of the plurality of members identified in the stored invitation information for

receiving an invitation, wherein each electronic invitation message invites its corresponding recipient to the events identified for that recipient in the invitation information (Fig.4, pg.5, using tables 98 and 100 - electronic message)

15. Gal fails to expressly disclose sending/generating/receiving an “e-mail” as described by the applicant, wherein each of the plurality of members has a corresponding electronic mailbox for receiving electronic communications for storage and later retrieval by that member.
16. However, Gal does disclose sending invitations which can be done by “e-mail” (pg.4 L8), and it would have been obvious to use a variety of available e-mail formats available at the time the invention was made to include an e-mail system that included an electronic mailbox for receiving electronic communications for storage and later retrieval by that member, for the purpose of providing customers with a wide variety of formats for receiving sent messages.
17. Furthermore, Gals fails to expressly disclose sending “all of” the matching events/invitations in one e-mail to the user.
18. However, Gal does disclose combining event information by user/key number (pg.5, combined event information disclosed as possible information available), and Gal also discloses electronically sending invitation information to users (pg.4).
19. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included sending “all of” the matching events/invitations in one e-mail to the use in the system disclosed by Gal, for the advantage of providing a method of invitation delivery with the ability to save system resources for both the user and the sender, by combining information sent. (See KSR [127 S Ct. at 1739] “The combination of familiar

elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

20. As per Claim 2 and 11, Gal discloses wherein the one or more corresponding invitee selection criteria comprises an area of practice (Fig.4, Occupation).
21. As per Claim 3 and 12, Gal discloses wherein the one or more corresponding invitee selection criteria for each of the plurality of events are selected by a sponsor of the respective event (C3 L8-15, user creates message with profile).
22. As per Claim 4 and 13, Gal discloses wherein the one or more corresponding invitee selection criteria comprises an identifier that uniquely identifies an individual member (C5 L6-12, e-mail address).
23. As per Claim 5 and 14, Gal discloses wherein the one or more corresponding invitee selection criteria comprises a list of identifiers, each of which uniquely identifies an individual member (e-mail address, web page).
24. As per Claim 8, Gal discloses wherein, in the comparing step, a decision to invite a given member to a given event requires (a) a match between the member information for the given member and the at least one invitee selection criterion for the given event and (b) a match between the event information for the given event and the member preference for the given member.
25. As per Claim 10, Gal discloses wherein, in the comparing step, a decision to invite a given member to a given event requires (a) a match between the member information for the given member and the at least one invitee selection criterion for the given event and (b) a match

between the event information for the given event and the member preference for the given member.

Response to Arguments

26. Applicant's arguments filed 1/28/2009, with respect to Claims 1-6, 8, and 10-14, have been considered but are not persuasive. The rejection will remain as Non-Final, based on the cited prior art and the new 101 rejection.
27. The Applicant is directed to the clarified rejection above in regards to the submitted arguments.

Conclusion

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
30. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

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May 26, 2009

/Jonathan Ouellette/

Primary Examiner, Art Unit 3629